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09/868,387	09/10/2002	Harri Vatanen	2132-47PCON	8959

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EXAMINER

HA, LEYNNA A

ART UNIT

PAPER NUMBER

2135

DATE MAILED: 12/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/868,387

Applicant(s)

VATANEN, HARRI

Examiner

LEYNNA T. HA

Art Unit

2135

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-17 is pending.
2. This is a Final rejection necessitated by new grounds of rejection.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35

U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. **Claims 1-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Nishioka, et al. (US 5,754,656).**

As per claim 1:

Nishioka, et al. teaches a method for digitally signing an electronic form in a secure manner by means of a mobile station said method comprising the steps of:

computing a first hash code for the material to be signed **[col.21, lines 58-61]**, the material to be signed including the form, an identifier of the form, shared information, and /or essential information; **[col.21, lines 6-10 and 62-65]**

transferring the material to be signed and the first hash code, to the mobile station, **[col.22, lines 3-5]**

digitally signing, using the mobile station, the material and the first hash code transferred to the mobile station; and **[col.22, lines 7-8]**

verify the authenticity of the signed and transferred material by comparing the signed hash code **[col.22, lines 53-58]** with the first hash code computed from the material before signature **[col.22, lines 42-45]**.

As per claim 2: See **col.22, lines 3-5**; discussing the first hash code is added to the material to be transferred to the mobile station.

As per claim 3: See **col.21, lines 6-10 and 62-65 and col.22, lines 40-42**; discussing the material to be signed is generated from an identifier of the form and essential information associated with the form.

As per claim 4: See **col.21, lines 58-61**; discussing computing the first hash code from the material to be signed before the material is transferred into the mobile station.

As per claim 5: See **col.22, lines 3-33**; discussing the material is transferred to the mobile station for signature from a second party and the signed material is transferred to the second party, whereupon the

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second party performs the step of verifying the authenticity of the signature.

As per claim 6: See col.21, lines 3-19; discussing the material is encrypted before being transferred between the mobile station and the second party and the encrypted material is decrypted before any treatment of the material, such as signature and verification of authenticity.

As per claim 7: See col.21, lines 6-14 and 62-65 and col.22, lines 40-42; discussing the form is generated using a pre-agreed form template provided with an identifier, the essential information being filled in the form template before it is transferred to the mobile station.

As per claim 8: See col.21, lines 59-61; discussing the hash code is generated using a hash function.

As per claim 9: See col.22, lines 8-10 and 57; discussing the signature and/or encryption of the message are implemented using a public and private key method.

As per claim 10: See col.21, lines 6-10 and 62-65 and col.22, lines 40-42; discussing the material and/or part of it is presented in the mobile station before the material is signed.

As per claim 11: See col.12, lines 27-28; discussing wherein the mobile station is started in signature mode before the transfer of the material into the mobile station.

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As per claim 12: See col.22, lines 1-2; discussing the material is stamped with the stamp, and the transaction of signature of the material is tiled after the signature has been authenticated.

As per claim 13:

Nishioka, et al. teaches a system for digitally signing an electronic form in a secure manner by a mobile station said system comprising:

a payment machine; **[col.21, lines 1-2; discusses the user site apparatus is in the form of a payment machine is a terminal for the user to insert the smart card into (col.9, lines 16-28) that communicates to the retail store apparatus where this payment apparatus issues commands for purchasing the desired products and thus is inherent the user site apparatus is where payment takes place in order to complete the purchase via the retail store apparatus (col.9, lines 3-5 and 10-13).]**

means connected to the payment machine for the generation of the material to be signed said material comprising a form, its identifier, shared data, and/or essential information added to it; and **[col.21, lines 6-14 and 62-65 and col.22, lines 40-42]**

means connected to the payment machine for the transfer of the material into the mobile station, wherein **[col.9, lines 34-50; discusses the smart card in the form of the mobile station where the smart card is mobile that can receive/transmit data, encrypt/decrypt unit, and a digitally signature unit. (col.9, lines 55-56 and col.22, lines 6-7).]**

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the payment machine comprises means for computing a first hash code from the material to be signed **[col.21, lines 58-66]** and means for transfer of the first hash code into the mobile station; **[col.22, lines 3-5]**

the mobile station comprise signing means for the signing of the material transferred into it; and **[col.22, lines 6-8]**

the payment machine comprises means for verifying the authenticity of the signed and transferred material by comparing the signed hash code **[col.22, lines 53-58]** with the hash code computed from the material before signature. **[col.22, lines 42-45]**

As per claim 14: See col.20, lines 54-57 and col.21, lines 4-5 and 18-19; discussing a server connected to the payment machine and the mobile station and controlled by a third party, and the mobile station comprises means for encrypting the signed material.

As per claim 15: See col.22, lines 49-55; discussing the server comprises means for the verification of authenticity of the digital signature.

As per claim 16: See col.21, lines 6-10 and 62-65 and col.22, lines 40-42; discussing the mobile station comprises means for presenting the material and/or part of it in the mobile station before the signing of the material.

As per claim 17: See col.22, lines 1-2; discussing means for stamping the material with a time stamp, and means for filing the transaction of signing of the material after the signature has been authenticated.

Response to Arguments

4. Applicant's arguments with respect to claims 1-17 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

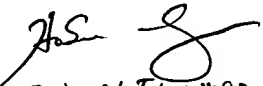
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to LEYNNA T. HA whose telephone number is (571) 272-3851. The examiner can normally be reached on Monday - Thursday (7:00 - 5:00PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LHa


primary Examiner
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